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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,951	12/08/2003	Kouichi Sugiyama	00862.023356.	9003

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EXAMINER
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THOMAS, ASHISH

ART UNIT	PAPER NUMBER
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2625

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02/17/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/728,951	<b>Applicant(s)</b> SUGIYAMA, KOUICHI	
	<b>Examiner</b> ASHISH K. THOMAS	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7, 8, 10-13, 15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7, 8, 10-13, 15, and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed on 12/2/2009, with respect to the 103 rejection of the claims, have been fully considered but they are not persuasive.

In page 8, paragraph 3-page 9, paragraph 1 of the remarks, the Applicant argues that the Iwasaki reference should not be used in the rejection since it is not analogous art. The Applicant asserts that the reference is not reasonably pertinent to the present invention: "techniques used to resolve scheduling problems for train crews are not at all pertinent to the problem at hand relating to dealing with banner data in combined print jobs."

In response, the Examiner respectfully disagrees with the Applicant. While the Iwasaki reference and the present application deal with problems in two different arenas-scheduling problems for crews and banner data in combined print jobs-the fact remains that both inventions disclose the core function of printing out newly generated data. It is for this reason that the Iwasaki reference is used in the rejection. Therefore, the Examiner reasonably believes that the Iwasaki reference is a pertinent reference.

In page 9, paragraph 2 of the remarks, the Applicant contends that the Iwasaki reference does not teach the second generation step stated in the claim language. That is, the Iwasaki reference fails to teach generating "new banner print data for printing new banner information different from the first banner information and the second banner information for the combined print job generated in the first generation step."

In response, the Examiner respectfully disagrees with the Applicant's assertion that the cited references do not teach the claimed subject matter. Please note that the Fischer reference was used to teach combining a plurality of jobs (figure 5). Meanwhile, the Noda reference was used to teach the concept of two different banner page data (column 5, lines 10-20). In Noda, all jobs pertaining to a specific user have one banner page. So, the combination of Fischer and Noda realizes combining a plurality of jobs wherein a set of jobs have one banner sheet. The Iwasaki reference was merely incorporated to teach the creation of new data from old data, not combining the old data rather the creation of new data (Column 7, lines 15-20 and 40-55). While the Iwasaki reference alone does not teach new banner print data for printing new banner information different from the first banner information and the second banner information for the combined print job generated in the first generation step, the combination of Fisher, Noda, and Iwasaki obviously does realize this.

2. Please note that the rejection under 35 U.S.C. section 112 first paragraph is hereby withdrawn.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 7, 8, and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer(U.S. 6,373,588) in view of Noda(U.S. 6,267,517) and further in view of Iwasaki(U.S. 6,249,741).

Regarding claim 7, Fischer teaches an information processing apparatus(**host 45 in figure 1**) for sending a print job to a printing apparatus(**printer 10 in figure 1**), said information processing apparatus having a printer driver for generating the print job(**Figure 2 illustrates a host that sends a job to a printer, thereby inherently teaching an associated driver**), comprising: a first generation unit adapted to generate a combined print job by combining a first print job and a second print job, the first print job including first page data and first banner print data for printing first banner information. (**Figure 5, step 325 teaches a multiple copy operation that combines all the copies. This reads on the combining a first and second print job. The first generation unit is inherently taught in this reference. Furthermore, figure 5, step 330 teaches that each print job consists of the banner data as well. This reads on the first banner print data stated in the claim language.**)

Fischer also teaches a sending unit adapted to send the first page data and the second page data to the printing apparatus, as the combined print job. (**Column 10, lines 13-25 teaches that the combined copy job is outputted. This, in turn, inherently teaches the sending unit stated in the claim language. Note that figure 1 illustrates this concept as well.**)

But Fischer is silent on the second print job including second page data different from the first page data and second banner print data for printing second banner information different from the first banner information.

Noda, on the other hand, teaches a second print job including second page data different from the first page data and second banner print data for printing second banner information different from the first banner information. **(Column 5, lines 10-20 teaches that a banner data is different for each user. This reads on the second banner print data being different from the first banner information.)**

Therefore, it would have been obvious for one of ordinary skill in the art, at the time of the present invention, to modify Fischer with Noda to put forth an information processing apparatus wherein a plurality of jobs are combined, each of the jobs having a different banner data.

The motivation behind the modification is to combine not just jobs with similar banner data but also combine jobs with different banner data. This way, if the user desires different jobs to be grouped together and printed at one location, it can be realized.

But the combination of Fischer and Noda fails to teach a second generation unit adapted to generate new data for printing new information, the new print is for printing new information different from the first information and the second information. This combination also fails to teach sending the new print data so that the new print information, without printing the first information and the second information is printed.

Iwasaki, on the other hand, teaches, a second generation unit adapted to generate new data for printing new information, the new print is for printing new information different from the first information and the second information. **(Column 7, lines 15-20 teaches N itineraries. The N itineraries read on the first and second information. This reference also teaches that the group schedule data is produced from combining the N itineraries. The group schedule data reads on the new print information. Note that the ability to produce the new group schedule data inherently teaches a generation unit that can generate it.)** Iwasaki also teaches sending the new print data so that the new print information, without printing the first information and the second information is printed. **(Column 7, lines 40-55 teaches the creation of the new data. Also note that printer 42 in figure 1 can print the newly combined data.)**

Therefore, it would have been obvious for one of ordinary skill in the art, at the time of the present invention, to modify Fischer and Noda with Iwasaki to fully put forth the apparatus claimed in claim 7 wherein a second generation unit adapted to generate new banner print data for printing new banner information wherein the new banner print is for printing new banner information different from the first banner information and the second banner information for the combined job. The combination also teaches sending the new banner print data so that the new banner print information, without printing the first banner information and the second banner information, is printed on a sheet.

The motivation behind this combination is to create revised data since the old banner data is no longer applicable since that only applies to the jobs before the combination.

Regarding claim 1, it is rejected in the same manner as claim 7 since a corresponding method claimed is disclosed.

Regarding claims 2 and 11, the combination of Fischer, Noda, and Iwasaki teaches the combined print job data is generated by disabling data execution of banner printing included in the first and second print jobs. **(Column 10, lines 13-25 of Fischer teaches that banner sheet is not outputted for each copy, rather only for the combined print job. This is an example of disabling banner data printing for each of the plurality of print jobs.)**

Regarding claims 3 and 12, Fischer teaches setting layout information on a number of pages laid out on a print sheet for the single print job. **(Column 2, lines 43-48 teaches page settings with respect to the document portion of the print job.)** Fischer also teaches that the layout information is applied to the combination print data without being applied to the banner print data, and the single print job is outputted to the printing apparatus in the output step. **(Column 2, lines 48-51 teaches that the layout information of the banner page is independent of the rest of the print data. Figure 4 teaches that the printer 10 outputs the combined job data.)**

Regarding claim 8, Fischer further teaches a computer-readable storage medium storing a computer-executable program for causing a computer to implement the printing control method. **(Column 3, lines 45-55)**



Regarding claims 10 and 13, Fischer teaches that banner print data is data indicating designation of banner printing or banner pages. (**Column 1, lines 15-25 details some examples of banner print data that is printed.**)

4. Claims 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer(U.S. 6,373,588) in view of Noda(U.S. 6,267,517), Iwasaki(U.S. 6,249,741), and Sakai(U.S. 5,887,223).

Regarding claim 15 and 17, the combination of Fischer, Noda, and Iwasaki teaches the subject matter claimed in the respective base claims. Fischer further teaches that user data such as the name of the user is included in the banner sheet(**column 1, lines 15-25**).

But this combination fails to teach that a print time is also included in the banner sheet.

Sakai, on the other hand, teaches that the print time is included in a banner sheet. (**column 8, lines 35-40**)

Therefore, it would have been obvious for one of ordinary skill in the art, at the time of the present invention, to modify Noda, Fischer, and Iwasaki with Sakai to fully put forth the subject matter claimed in claims 15 and 17.

The motivation behind this modification is to provide a banner sheet with as much as information as possible so that the user can easily distinguish the printed jobs.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ASHISH K. THOMAS whose telephone number is (571)272-0631. The examiner can normally be reached on Mon-Fri from 0700-1530 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ashish K Thomas/  
Examiner, Art Unit 2625

/David K Moore/  
Supervisory Patent Examiner, Art Unit 2625